REMARKS

Claims 1-22 were pending in this application.

Claims 1-22 have been rejected.

Claims 1 and 14 have been amended in this Response.

Claims 1-22 remain pending in this application.

Reconsideration of Claims 1-22 is respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 103

The Office Action rejected Claims 1-22 under 35 U.S.C. § 103(a). Claims 1, 4, 10-13, 14, 17 and 22 were rejected as being unpatentable over U.S. Patent No. 6,002,393 to Hite et al. ("*Hite*") in view of U.S. Patent No. 6,698,020 to Zigmond et al. ("*Zigmond*"). Claims 2 and 15 were rejected as being unpatentable over *Hite* and *Zigmond*, further in view of U.S. Patent No. 6,029,045 to Picco et al. ("*Picco*"). Claims 3 and 16 were rejected as being unpatentable over *Hite* and *Zigmond*, further in view of U.S. Patent No. 6,442,755 to Lemmons et al. ("*Lemmons*"). Claims 5 and 18 were rejected as being unpatentable over *Hite* and *Zigmond*, further in view of U.S. Patent Publication No. 2002/0057893A1 to Wood et al. ("*Wood*"). Claim 7 was rejected as being unpatentable over *Hite* and *Zigmond*, further in view of U.S. Patent No. 6,745,224 to D'Souza et al. ("*D'Souza*"). Claims 9 and 21 were rejected as being unpatentable over *Hite* and *Zigmond*, further in view of U.S. Patent No. 6,177,931 to Alexander et al. ("*Alexander*"). Claims 8 and 20 were rejected as being

unpatentable over *Hite* and *Zigmond*, further in view of U.S. Patent No. 5,892,535 to Allen et al. ("*Allen*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. MPEP § 2142.

The *Hite* reference describes an electronic system for delivering TV commercials targeted to an individual viewer. *See Hite, col. 1, lines 6-9.* However, as the Office Action acknowledges, *Hite* does not teach detecting a first swap signal. The *Zigmond* reference shows a system for selecting and inserting advertisements into video programming. *See Zigmond, col. 1, lines 7-11.* The Office Action asserts that *Zigmond* teaches a first swap control signal at column 8, lines 30-41, where the system is described as toggling between a video programming feed and an advertisement stream in response to a designated signal, encoded in the video programming feed.

Independent Claims 1 and 14, as amended, recite an addressable advertising system and method that detect a first swap control signal and associated channel identifier and, in response to the swap signal and channel identifier, cause a selected replacement video advertisement to be transmitted to a display. The Applicants respectfully submit that neither *Hite* nor *Zigmond* describes transmitting a replacement video advertisement to a display in response to detection of a swap control signal and associated channel identifier. Furthermore, the Applicants respectfully submit that none of the *Picco*, *Lemmons*, *Wood*, *D'Souza*, *Alexander*, and *Allen* references teaches such a limitation.

Therefore, the cited prior art references, either alone or in combination, do not disclose, suggest or hint at all the claim limitations of independent Claims 1 and 14 as amended. Claims 2-13 and 15-22 depend from Claims 1 and 14, respectively, and contain their limitations. The Applicant respectfully requests that the rejection of Claims 1-22 under 35 U.S.C. § 103(a) be withdrawn and that Claims 1-22 be passed to allowance.

VII. CONCLUSION

For the reasons given above, the Applicant respectfully requests reconsideration and full allowance of all pending claims and that this application be passed to issue.

The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicant reserves the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com.*

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: Sept. 21, 2004

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